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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,117	01/16/2004	Carrell W. Ewing	40026 - XA	5022

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EXAMINER

PATEL, ASHOKKUMAR B

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,117

Applicant(s)

EWING ET AL.

Examiner

Ashok B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/16/05, 2/5/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Application Number 10/758, 177 was filed on 10/19/2000. Claims 6-24 are subject to examination. Claims 1-5 are cancelled.

Priority

2. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Referring to claim 12,

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The instant application's incorporation of "remotely detecting a wiring inadequacy with a particular network appliance" which Examiner was unable to locate in the application 08/685, 436. And as such, the priority date for claim 12 was considered as being 08/16/1999.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4a. Claims 17-24 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1, 5, 6, 8, 9, 10, 11 and 12 of prior U.S. Patent No. 6, 711, 613. This is a double patenting rejection.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5a. Claims 6-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 8, 9, 10, 11, 12. of U.S. Patent No. 6, 711, 613.

Instant Application 10/758, 117	U.S. Patent 6, 711, 613	Differences and reasons for obviousness
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Claims 6,7, 8, 9, 10,11,	Claim 1	The claims 6-11 of instant Application 10/758, 117 identify the plurality of network appliances receiving power from a corresponding one of a plurality of IPMs wherein each IPM can cycle operating power on/off to said corresponding network appliances while Claim 1 of U.S. Patent 6, 711, 613 identifies the IPMs connected between the UPS and plurality of networking devices. It is well known in the art that UPS can provide power to multiple devices through multiple outlet receptacles simultaneously in various operating modes. Therefore, it would have been obvious for one in ordinary skill in the art at the time the invention was made to remove the UPS and connect network appliances to various other sources of power supply to IPMs such that output of each of these power supply sources can be individually controlled in the same manner as each AC output of an UPS by their corresponding IPMs.
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Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Referring to claim 12,

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Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "detecting a wiring inadequacy associated with a particular network appliance" in claim 12 is used by the claim to mean "a probable wiring error", while the accepted meaning is "wiring size (gauge as described in National Electric Code (NEC)) is inadequate to carry on ongoing basis the power that a particular network appliance is consuming since the instant application is all about controlling power to network appliances" The term is indefinite because the specification does not clearly redefine the term.

Referring to claim 13,

Claim 13 recites the limitation "the logic status" in line 3. There is insufficient antecedent basis for this limitation in the claim

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Bailey et al. (hereinafter Bailey) (US 5, 909, 0180).

Referring to claim 6,

The reference teaches a method for operating a remote power management system (Fig. 2, Fig. 7, element 36), the method comprising the steps of:

(a) configuring a plurality of network appliances to receive operating power (Fig. 4, elements 20) from a corresponding one of a plurality of intelligent power modules (IPM's) (Fig. 4, element 60, col. 6, lines 33-54) such that each IPM can cycle operating power on/off to said corresponding network appliances in response to a command issued by a host system;(col. 3, lines 36-38, col. 6, lines 64-67," The status signals provided by the selected circuit breaker 20 are filtered by noise filters 64 before being provided to the gate array 60, which transmits the circuit breaker status to the controller 32 through the optical isolator 50." col. 20, lines 17-34)

(b) providing a power manager in communications with said host system and said plurality of intelligent power modules (Fig. 5a, col. 14, lines 9-11," A power supply 136, fed by a conventional AC line, may be used to provide power to the circuits contained within the housing 132, and a network driver circuit 140 may be used to interface the microcomputer 134 with a communication network or protocol required for communication with the load centers.");

(c) providing a first command from said host system to said power manager (Fig. 4, element 32 incorporating "Data Mux", element 59) identifying a particular intelligent power module ;(d) receiving a confirmation at said host system that said particular

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intelligent power module is responding to said first command (Fig. 5b, col. 3, lines 64 through col. 4, line 10); and

(e) providing a second command from said host system to said power manager commanding said particular intelligent power module to shut-off operating power to a particular one of the network appliances receiving operating power therefrom. (col. 6, lines 33-67).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. (hereinafter Bailey) (US 5, 909, 0180) in view of Fujino et al. (herein after Fujino)(US 5, 651, 006)

Referring to claim 7,

Keeping in mind the teachings of the reference Bailey as stated above, although the reference teaches the host system and power manager to control a particular circuit breaker over the network (col. 6, lines col. 3, lines 64 through col. 4, line 10), the reference fails to explicitly teach the method of claim 6 further comprising: providing a Transfer-control-protocol/Internet-protocol (TCP/IP) communication link between said host system and said power manager; and communicating between said host system and said power manager via said TCP/IP communication link. The reference Fujino

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teaches "Each of the sub-managers functions as an agent to the integration manager and functions as a manager to each agent, so that it becomes possible to employ a Simple Network Management Protocol (SNMP) between each agent and its sub-manager and between a sub-manager and the integration manager." (Abstract). Therefore, it would have been obvious for one in ordinary skill in the art at the time the invention was made to employ SNMP over TCP/IP in a hierarchical manner as a communication protocol between the host (Fig. 7, element 36 of Bailey) and power manager (Fig. 2, element 32) such that the combines system provides a hierarchical network management system which can transmit management information between an integration manager (host) and sub-managers (power managers) based on a small volume of management packets and which can manage a large-scale communication network with low traffic and at low cost as taught by Fujino.

Referring to claims 8, 9, 10 and 11,

The reference Bailey teaches "independently communicating for at least one of power-on sensing, load sensing, power cycling on/off, and tickle signal generation", and "host system communicating effecting at least two of said power-on sensing, load sensing, power cycling on/off, and tickle signal generation, and effecting at least three of said power-on sensing, load sensing, power cycling on/off, and tickle signal generation, and effecting all of said power-on sensing, load sensing, power cycling on/off, and tickle signal generation (col. 3, lines 64 through col. 4, line 10, col. 20, lines 17-34). The reference fails to explicitly teach providing a network agent at said power manager and independently communicating a TCP/IP message to said network agent from host

system. The reference Fujino teaches "Each of the sub-managers functions as an agent to the integration manager and functions as a manager to each agent, so that it becomes possible to employ a Simple Network Management Protocol (SNMP) between each agent and its sub-manager and between a sub-manager and the integration manager." (Abstract) (Providing a network agent at said power manager and independently communicating a TCP/IP message to said network agent from host system). Therefore, it would have been obvious for one in ordinary skill in the art at the time the invention was made to employ SNMP over TCP/IP in a hierarchical manner as a communication protocol between the host (Fig. 7, element 36 of Bailey) and power manager (Fig. 2, element 32) such that the combined system provides a hierarchical network management system which can transmit management information between an integration manager (host) and sub-managers (power managers) based on a small volume of management packets and which can manage a large-scale communication network with low traffic and at low cost as taught by Fujino.

Referring to claim 12,

The reference Bailey teaches generating a signal and transmitting said signal to said host system identifying a particular one of said corresponding plurality of network appliances associated with a target one of the plurality of intelligent power modules, (Fig. 5b). The reference Bailey teaches generating a tickle signal by the power manager in response to receiving an initiating message from said host system (col. 3, lines 64 through col. 4, line 10); and remotely detecting a wiring inadequacy associated with a particular network appliance among the plurality of network appliances without

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adversely affecting the power supplied by said one among the plurality of IPM'S to said particular network appliance. (col. 20, lines 17-21, "Part IV consists of four sheets of commands sent from the controller and proper responses from the gate array. The first sheet includes 42 commands which may be used to instruct each of the 42 circuit breakers to report as to whether or not a motor (or circuit breaker) is present in the load center") The reference fails to explicitly teach generating and transmitting signal through TCP/IP communication link. The reference Fujino teaches "Each of the sub-managers functions as an agent to the integration manager and functions as a manager to each agent, so that it becomes possible to employ a Simple Network Management Protocol (SNMP) between each agent and its sub-manager and between a sub-manager and the integration manager." (Abstract) (generating and transmitting signal through TCP/IP communication link.). Therefore, it would have been obvious for one having an ordinary skill in the art at the time the invention was made to employ SNMP over TCP/IP in a hierarchical manner as a communication protocol between the host (Fig. 7, element 36 of Bailey) and power manager (Fig. 2, element 32) such that the combined system provides a hierarchical network management system which can transmit management information between an integration manager (host) and sub-managers (power managers) based on a small volume of management packets and which can manage a large-scale communication network with low traffic and at low cost as taught by Fujino.

Referring to claims 13, 14 and 15,

The reference Bailey teaches the method of claim 12 further comprising generating a tickle signal by each of the plurality of intelligent power modules which comprises a dry-

contact relay output signal determining the logic status of a signal receiving interface in an associated network appliance. (col. 3, lines 64 through col. 4, line 10), and the method of claim 13, further comprising answering said tickle signal by said associated network appliance by issuing a first signal when in a normal operating mode, and the method of claim 13, further comprising answering said tickle signal by said associated network appliance by issuing a second signal when in an abnormal operating mode. (col. 20, lines 17-34).

Referring to claim 16,

The reference Bailey teaches the method of claim 6, further comprising issuing a series of sensing pulses from ones of the plurality of intelligent power modules to corresponding ones of said plurality of network appliances, and reading and reporting any results that indicate a switched-on or switched-off condition. (col. 20, lines 17-34).

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp



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